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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,559	01/23/2004	Katsunori Takada	K06-165935M/TBS	3219
21254 7590 03/08/2007 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			EXAMINER MCNELIS, KATHLEEN A	
			ART UNIT	PAPER NUMBER
			1742	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/08/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/762,559

Applicant(s)

TAKADA ET AL.

Examiner

Kathleen A. McNelis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/01/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **Claims Status**

Claims 1-21 remain for examination wherein claims 20 and 21 are new.

### **Status of Previous Rejections**

The following rejections are maintained:

Claims 1 to 8 and 15 under 35 U.S.C. 102(b) as being anticipated by Iguchi et al. (U.S. Pat. No. 6,270,596).

Claims 1 to 8 and 15 under 35 U.S.C. 103(a) as being unpatentable over Iguchi et al. (U.S. Pat. No. 6,270,596).

Claims 9 to 14 and 16 to 19 under 35 U.S.C. 103(a) as being unpatentable over Iguchi et al. (U.S. Pat. No. 6,270,596).

### **DETAILED ACTION**

#### ***Claim Objections***

Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 20 recites that the steel in claim 1 comprises a material other than Cr, Cu, Ni and Al.

Claim 1 recites that the steel contains C, Si, Mn, Mo, B, Ti and Fe.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner does not find literal support for a f value of not more than 0.50 in the original disclosure.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 to 8, 15, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Iguchi et al. (U.S. Pat. No. 6,270,596).

Iguchi et al. is applied as set forth in the 08/15/2006 Office action.

Regarding new claim 20, Iguchi et al. discloses that the steel comprises Fe, C, Si, Mn, Mo, B and Ti (abstract).

With respect to new claim 21, steel no. 7 in Table 1 when calculated has f value less than 0.05.

Claims 1 to 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iguchi et al. (U.S. Pat. No. 6,270,596).

Iguchi et al. is applied as set forth in the 08/15/2006 Office action.

Regarding new claim 20, Iguchi et al. discloses that the steel comprises Fe, C, Si, Mn, Mo, B and Ti (abstract).

With respect to new claim 21, steel no. 7 in Table 1 when calculated has f value less than 0.05.

### ***Response to Arguments***

Applicant's arguments filed 12/15/2006 have been fully considered but they are not persuasive.

Applicant argues that Iguchi does not teach hot rolling the steel in accordance with the specific process described in the application because the instant invention discloses that the temperature is 850 °C or lower and preferably 700 °C or higher under a draft ratio of 10% or more, while Iguchi discloses hot rolling at up to 1050 °C.

Examiner's response is that the temperature range of 700 to 850 °C is within the range disclosed by Iguchi et al. of up to 1050 °C and the reduction in area of up to 30% (Iguchi et al. col. 4 line 54 – col. 5 line 7) would include a draft (i.e. reduction in thickness) of 10%. Further, it is well settled that where the principal difference between a claimed process and that taught by reference is a temperature difference, it is incumbent upon applicants to establish the criticality of that difference (Ex parte Khusid, et al., 174 USPQ 59).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen A. McNelis whose telephone number is 571 272 3554. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAM  
03/04/2007

Km

ROY KING  
SUPERVISING PATENT EXAMINER  
TECHNICAL STAFF